

**REMARKS**

In this response claims 80 through 83 and 92 through 96 are canceled. New claims 97 to 115 are presented. It is believed that these new claims better define Applicant's invention. Claims 97 to 106 are directed to a method for processing a tissue sample in which a robotic system is used to move a tissue sample, an ultrasound transducer and a sensor from a first reaction chamber to a next chamber. New claims 107 to 115 are directed to a robotic system in which this method is carried out. Reconsideration of this application in view of the foregoing amendments and the following remarks is respectfully requested.

**Rejections Under 35 U.S.C. § 112, second paragraph:**

Claims 80 through 83 and 92 through 96 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It was asserted that claims 80 and 92 are vague and confusing because it is not clear how the sample or tissue is related to the robotic system. In response Applicant submits that new claims 107 to 115 directed to the robotic system which make clear that the tissue sample, ultrasound transducer and sensor are moved by a robotic system from a first reaction chamber to a series of next reaction chambers as the steps of the novel method of processing or fixing the tissue of the present application are carried out. New claims 97 to 106 are directed to the method where the tissue sample, ultrasound transducer and sensor are moved from the first reaction chamber to each subsequent reaction chamber used in the method. Applicant respectfully asserts that the present claims make clear the relationship between the tissue sample and robotic system and respectfully ask that the outstanding rejection be withdrawn as it may be applied to the new claims.

Claims 92-96 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. It was asserted that "systems of robotics" were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention at the time the application was filed. Applicant respectfully asserts that one of skill in the art of the processing clinical tissue samples would readily understand that the automated operations carried out by the robotic system of the present application could readily be carried out by "systems of robotics."

Nevertheless, the term "systems of robotics" is not used in the newly submitted claims. Applicants respectfully ask that this rejection be withdrawn as it may be applied to new claims 97-115.

**Rejection Under 35 U.S.C. § 112, first paragraph:**

Claims 80 through 83 and 92 through 96 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office action asserts that there is no literal support for a system of robotics in the originally filed specification, nor is there support for a plurality of robotics. This rejection is traversed as it may be applied to new claims 97-115.

The use of robotic systems in clinical labs for processing of tissue samples was well known at the time the present application was filed as is demonstrated by the patents and other materials previously submitted in the response filed on October 7, 2005. It has long been the law that it is not necessary to spell out every detail of the invention in the specification; only enough description must be included to convince a person of skill in the art that the inventor possessed the subject matter of his claims. A claim does not lack written description support simply because embodiments of the specification do not contain explicit descriptions of elements that are known to those of skill in the relevant art. Patent specifications are written for the person of skill in the art, and such a person comes to the patent with the knowledge of what has come before. *In re GPAC Inc.*, 57 F. 3d 1573, 1579 (Fed. Cir. 1995).


"The written description requirement states that the patentee must describe the invention; it does not state that every invention must be described in the same way." *Capon v. Eshhar v. Dudas*, 418 F.3d 1349, 1358 (Fed. Cir. 2005). As each field evolves, the balance also evolves between what is known and what is added by inventive contributions. The novel process for fixation of tissues disclosed in the present application can be readily adapted to use with an automated robotic system as described in Example 6 of the application. Accordingly, Applicant respectfully asks that the rejection under the first paragraph of Section 112 be withdrawn as it may be applied to the newly submitted claims.

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**Conclusion:**

It is submitted that new claims 97 - 115 are allowable when considered in view of the comments made above. A timely notice to that effect is earnestly solicited.

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